

DOCKET NO. IZ-200308-001 (SAMS04-08001)  
U.S. Serial No. 10/693,089  
PATENT

**REMARKS**

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Claims 1, 5, 8, 11, 15 and 18 have been amended as shown above. Because these amendments place the claims in better condition for allowance or appeal, these amendments comply with 37 C.F.R. § 1.116.

Reconsideration and full allowance of Claims 1-20, as amended, is respectfully requested.

**Claim Rejections under 35 U.S.C. § 102(b)**

The Office Action mailed February 28, 2006, finally rejects Claims 1 and 4-7 as anticipated by Worthington (US2002/0121792, hereinafter "Worthington"). The Applicant respectfully traverses the rejection.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP §2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

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The Applicants respectfully direct the Examiner's attention to amended independent Claim 1, which recites the unique and non-obvious limitations emphasized below:

A tool for lifting a pad, comprising:

a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the lower jaw portion having outer and inner surfaces, wherein the inner surface is substantially flat and not parallel to the outer surface, the inner surface being operable to receive a portion of the pad;

a first member pivotally coupled to the non-pivoted jaw structure; and

a second member pivotally coupled to the first member, the second member having a surface opposite to the inner surface of the lower jaw portion and operable for clamping the portion of the pad against the inner surface when the first member is pivoted upwards. (*Emphasis added*).

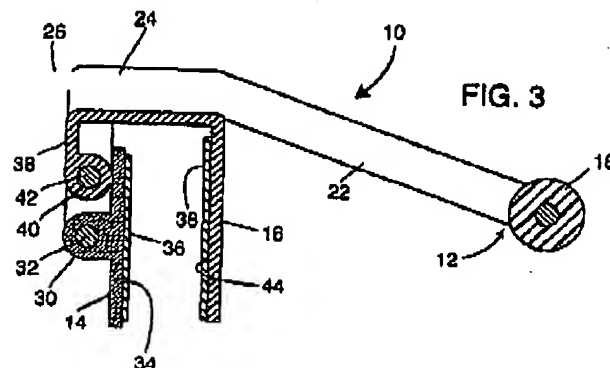
The Applicant respectfully asserts that the above-emphasized limitations are not disclosed in the Worthington reference.

The Office Action asserts that Worthington's U-shaped bracket 16, extension 38, and cushion insert 36, describe the recited limitations of a non-pivoted jaw structure, an upper jaw portion, and a lower jaw portion, respectively. Figure 3 of Worthington is reproduced below:

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As may be seen in Figure 3, cushion insert 36, on one side of an unnumbered extension of U-shaped bracket 16, is parallel to the opposite face of that extension. Assuming, without admitting, that the unnumbered extension of U-shaped bracket 16 teaches a lower jaw portion of a jaw structure and cushion insert 36 teaches an inner surface of the lower jaw portion, it is clear from Figure 3 that the outer surface of the lower jaw portion is parallel to the inner surface. Furthermore, there is no teaching elsewhere in the Worthington specification of any other configuration of the U-shaped bracket. In contrast, amended Claim 1 recites a jaw structure having a lower jaw portion with non-parallel inner and outer surfaces. As such, the Worthington reference fails to teach each and every limitation of the Applicant's invention as recited in Claim 1.

For these reasons, amended independent Claim 1 presents patentable subject matter not taught or suggested by Worthington. Additionally, dependent claims 4-7, which depend from Claim 1, contain all of the unique and novel limitations recited in independent Claim 1. Claims 4-7 are therefore patentable over Worthington.

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The Office Action mailed February 28, 2006, finally rejects Claims 1-5, 7-11, and 14 as anticipated by Krauss (US 6,086,126, hereinafter "Krauss"). The Applicant respectfully traverses the rejection.

The Office Action asserts that gripping slot 20 describes a non-pivoted jaw structure with upper and lower jaw portions (edges 20a and 20b, respectively). The Office Action further argues that torsion spring 32 teaches a first member pivotally coupled to gripping slot 20. Finally, the Office action asserts that clamping element 26 describes a second member pivotally coupled (indirectly) to the torsion spring 32. The Applicant respectfully submits that the Office Action mischaracterizes the teaching of Krauss.

Krauss describes a circuit board gripper 10 having a center plate 14 with side plates 16 and 18 attached on each side of the center plate. *See Krauss, Fig. 2, col. 3, lines 44-47.* Plate 16 (and identical plate 18) have mounting segment 16a and gripping segment 16b that, together, define gripping slot 20, relied upon by the Office Action. *See Krauss, Fig. 1, col. 3, line 61, through col. 4, line 2.* A fixing pin 30 is fastened between the side plates 16 and 18. *See Krauss, Fig. 1, col. 4, lines 29-31.* Torsion spring 32 is mounted on the fixing pin 30 between the side plates 16 and 18. *See Krauss, Fig. 1, col. 4, lines 32-33.*

Clamping element 26 is movably mounted to pivot pin 28 that passes through, and is fastened to, side plate 16 in gripping segment 16b. *See Krauss, Fig. 1, col. 4, lines 5-10.* Tension spring 32 causes clamping element 26 to rotate relative to side plate 16 in order to clamp a circuit board against mounting segment 16a. Thus, rather than being pivotally coupled, directly or indirectly, to torsion spring 32, as asserted by the Office Action, Krauss clearly describes the clamping element 26 as

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movably mounted to side plate 16, relied upon by the Office Action as describing the non-pivoted jaw structure of Claim 1. Assuming, without admitting, that side plate 16 describes a non-pivoted jaw structure and clamping element 26 describes a second member, as asserted in the Office Action, the clear teaching of Krauss is that the second member is movably mounted to the non-pivoted jaw structure. In contrast, amended independent Claim 1 recites a non-pivoted jaw structure, a first member pivotally coupled to the jaw, and a second member pivotally coupled to the first member.

For these reasons, Claim 1 presents patentable subject matter not taught or suggested by Krauss. Additionally, dependent claims 2-5 and 7, which depend from Claim 1, contain all of the unique and novel limitations recited in independent Claim 1. Claims 2-5 and 7 are therefore patentable over Krauss.

Furthermore Claim 8 recites limitations that are analogous to the unique and novel limitations recited in Claim 1. This being the case, Claim 8 is patentable over Krauss. Dependent Claims 9-11 and 14, which depend from Claim 8, contain all of the unique and novel limitations recited in independent Claim 8. Thus, Claims 9-11 and 14 are patentable over Krauss.

#### **Claim Rejections Under 35 U.S.C. § 103 (a)**

The final Office Action of February 28, 2006, rejected Claims 2, 3, and 8-20 under 35 U.S.C. § 103(a) as being unpatentable over Worthington in view of Krauss. With regard to claims 2, 3, and 8-14, the foregoing has demonstrated that limitations of independent claims 1 and 8 are not taught or suggested by Worthington or Krauss. As each of them fails to teach or suggest claim limitations, the combination of these references similarly fails to teach or suggest the claim limitations. This being

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the case, Claims 2, 3 and 8-14 are patentable over Worthington and Krauss, individually or in combination.

Amended independent Claim 15 recites limitations that are analogous to the unique and novel limitations recited in amended independent Claims 1 and 8. This being the case, Claim 15 is patentable over Worthington, Krauss, or the combination of Worthington and Krauss. Dependent Claims 16-20, which depend from Claim 15, contain all of the unique and novel limitations recited in independent Claim 15. Thus, Claims 16-20 also are patentable over Worthington and Krauss.

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

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**SUMMARY**

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@munckbutrus.com](mailto:wmunck@munckbutrus.com).

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date:

*April 28, 2006*

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